

REQUEST FOR WITHDRAWAL OF FINAL STATUS OF REJECTION
UNDER MPEP §706.07(d)

It is respectfully requested that the Final status of the outstanding rejection be withdrawn, because the rejection introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in a late-filed information disclosure statement. (See MPEP §706.07(a)).

The outstanding Final Office Action specifies new ground(s) for rejection, referencing claims 1-26 having been amended with the new limitation of "transmitting, with a measurement device, the measured sports activity information to a receiving device". The newly-cited reference to U.S. Patent No. 6,032,108 issued to Seiple et al. is applied to these features in the claims, but which were also present in the original claims.

Accordingly, the Final Office Action applies a new reference against pre-existing features. Accordingly, the rejection states new grounds, citing art which reasonably should have been cited in the first Office action.

MPEP §706.07(b) states:

The claims of a new application may be finally rejected in the first Office action in those situations where ... (B) all claims of the new application ...
(2) would have been properly finally rejected *on the grounds and art of record* in the next Office action if they had been entered in the earlier application.

MPEP §706.07(a) states:

706.07(a)Final Rejection, When Proper on Second Action
... Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement ...

MPEP §706.07(a) further sets forth standard paragraph 7.40.01, Note 1:

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.

The new grounds were not necessitated by amendment, except for the fact that the amendment properly overcame the previous grounds for rejection. With reference to the rejections as applied in the Final Office Action, the reference should properly have been cited in the first Office Action. In other words the new grounds were not "necessitated by applicant's amendment of the claims". (MPEP §706.07(a).) Therefore, a Final Rejection at this time would deny Applicants "a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action of December 15, 2008, are respectfully requested in view of this amendment and the following reasons. By this amendment, claims 1 and 19 have been amended. Accordingly, claims 1-26 are pending in this application.

Claims 1 and 19 have been amended to clarify the antecedent basis for the use of the receiving device during the providing of information. It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

In the outstanding Office Action, the Examiner rejected claims 1-26 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,790,178 issued to Mault et al. (hereinafter *Mault*), taken in view of U.S. Patent No. 6,032,108 issued to Seiple et al. (hereinafter *Seiple*).

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1-26 under 35 U.S.C. 103(a) over *Mault* in view of *Seiple*. The *Seiple* reference is cited as allegedly disclosing the "selecting" feature (i.e., selecting, based on the sport in question, from the received sports activity information a predefined set of pieces of sports activity information with the receiving device). The *Mault* reference is cited as allegedly disclosing the rest of the features.

Response

This rejection is traversed as follows. To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. *See Dystar Textilfarben GMBH v. C. H. Patrick*, 464 F.3d 1356 (Fed. Cir. 2006). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 1366.

Applicants' claims set forth:

... transmitting ... the measured sports activity information to a receiving device via a communication link during the activity; selecting, based on the sport in question, from the received sports activity information a predefined set of pieces of sports activity information with the receiving device; and providing ... feedback based on the selected sports activity information. (Claim 1; claims 10, 13 and 19 similar.)

The cited references fail to suggest the claimed feature of, "selecting, based on the sport in question". Therefore, there is no suggestion of selecting, based on the sport in question, from the received sports activity information a predefined set of pieces of sports activity information with the receiving device.

The Examiner admits that *Mault* fails to teach the methodology of selecting for transmitting the sport activity feedback to the receiving device. The Examiner thus alleges that *Seiple* discloses this missing feature.

That assertion is respectfully traversed. Specifically, the referenced section in *Seiple*, column 10, lines 1-13, fails to suggest the afore-mentioned feature. To the contrary this text concerns post event analysis and post event analysis software in another device (i.e., personal computer; see column 9 lines 58-67). In this respect, *Seiple* actually "teaches away from" Applicants' claimed subject matter.

Applicants respectfully submit that claim 1 is directed to an arrangement in which sports activity information is transmitted from a measurement device to a receiving device. This receiving device selects the predefined set of pieces of sports activity information, and the same receiving device gives the feedback to the user. It is clear that, when attempting to read *Seiple* into the wording of claim 1, the wrist watch display 10 is the claimed receiving device which receives information from other units; however, this fails to suggest the "selecting" feature. Applicants respectfully submit that in order to be within the scope of claim 1, it is this wrist watch display 10 that should perform the "selecting" feature. The passage on column 10, lines 1-13, though, completely fails to suggest this feature or anything related to this feature. Specifically, according to this passage and the passage immediately preceding that it is clear that the post analysis is performed in the PC, and specifically not in the wrist computer 10.

Accordingly, *Seiple* is used to show a *different* feature in a *different* arrangement to provide *different* information.

The cited prior art combination therefore fails to show or suggest Applicants' claimed subject matter as set forth in claims 1, 10, 13 and 19. It is therefore respectfully submitted that the rejection under 35 U.S.C. 103(a) should be withdrawn.

Examiner's Response to Applicants' Prior Arguments

The Examiner's acknowledgement of Applicants' arguments with respect to the cited art is noted. It is respectfully pointed out that the basis for Applicants' arguments still remains in view of the new grounds for rejection, under the newly-cited art. Accordingly, Applicants refer again to these arguments with respect to the current rejections.

CONCLUSION

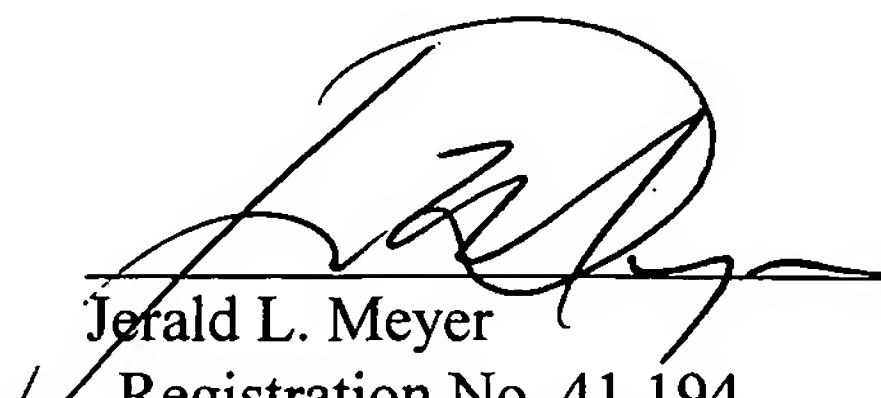
Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative at the number below to expedite prosecution.

Respectfully submitted,
THE NATH LAW GROUP

February 12, 2009

THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314-2891
Tel: 703-548-6284
Fax: 703-683-8396


Jerald L. Meyer
Registration No. 41,194
Derek Richmond
Registration No. 45,771
Stanley N. Protigal
Registration No. 28,657
Customer No. 20529